



Paper No. 8

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**OFFICE OF PETITIONS
A/C PATENTS**

In re Application of :
Harmon, Butts, Battaile, Heilman, :
Caglar, Marchala, Carner, and Varma: DECISION REFUSING STATUS
Application No. 09/637,984 : UNDER 37 CFR 1.47(a)
Filed: 11 August, 2000 :
Attorney Docket No. SYNOPSIS-007

This is in response to the petition under 37 CFR 1.47(a), filed on 22 March, 2001.

The petition is dismissed.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to respond, correcting the below-noted deficiencies. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)" and may include an oath or declaration executed by the inventor. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed on 11 August, 2000, without an executed oath or declaration.

Accordingly, on 19 October, 2000, a "Notice To File Missing Parts of Application" was mailed, requiring an executed oath or declaration, and a surcharge for its late filing.

In response, on 26 June, 2000, petitioner filed, *inter alia*, the instant petition under 37 CFR 1.47(a), and (a) the required petition fee and surcharge for late filing; (b) a request and payment for a three (3) month extension of time to reply to the Notice to File Missing Parts; (c) a declaration naming Bruce Harmon, Michael Butts, Gordon Battaile, Kevin Heilman, Levent

Caglar, Raju Marchala, Larry Carner, and Kamal Varma as joint inventors and signed by all inventors except Marchala on behalf of themselves and inventor Marchala; (d) a statement of the last known address of non-signing joint inventor Marchala, and (e) a declaration of facts by Thomas Haverstock.

Petitioners assert that the non-signing joint inventor cannot be found or reached to sign the Declaration.

A grantable petition under 37 CFR 1.47(a) requires:

(1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

(2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;

(3) the petition fee;

(4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and

(5) a statement of the last known address of the non-signing inventor.

The petition lacks item (1).

The petition lacks item (1). In regards to item (1), petitioner has not submitted sufficient evidence to prove that diligent efforts have been made to locate the non-signing inventor. Specifically, the showing of record, a single mailing to the last known address, is insufficient to prove that diligent efforts were made to locate the non-signing inventor.¹ Petitioner should explain what attempts were made to obtain a forwarding address and to locate the inventor through other means. If attempts to obtain a forwarding address and to locate the inventor by other means (e.g. though e-mail, the Internet, or the telephone) continue to fail, then applicant will have established that the inventor cannot be reached. Details of the efforts made to locate the non-signing inventor should be set forth in an affidavit or declaration of facts by a person having *first hand* knowledge of the details. The specific dates and times that the application was mailed and other attempts, such as telephone calls or e-mail searches, were made should be included.

¹ See MPEP 403.03(d).

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
 Box DAC
 Washington, D.C. 20231

By FAX: (703) 308-6916
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Telephone inquiries concerning this matter may be directed to the undersigned at (703)308-6918.



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